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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09 784,739

02/14/2001

Surya K. Goli

PF-0162-3 DIV

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08/28/2002

INCYTE GENOMICS, INC.
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EXAMINER

HINES, JANA A

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,739

Applicant(s)

GOLI ET AL.

Examiner

Ja-Na A Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
_____ is/are the serial number(s) of the provisional application(s) from which domestic priority has been received.

Administrative

- 1) ☐ Notice of References cited in formal examination.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849).
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Preliminary Amendment.
- 5) ☐ Notice of Informal Patent Application (PTO-152).
- 6) ☐ Other _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 6 are drawn to a purified polypeptide and method for producing said polypeptide, classified in class 930, subclass 10.
 - II. Claims 2-4 and 8-9 are drawn to an isolated polynucleotide and host cell, classified in class 435, subclass 91.1.
 - III. Claim 5 is drawn to a transgenic organism, classified in class 800, subclass 4.
 - IV. Claim 7 is drawn to isolated antibody, classified in class 530, subclass 388.1.
 - V. Claims 10-11 are drawn to a method for detecting a target polynucleotide in a sample comprising a hybridization step, classified in class 435, subclass 91.2.
 - VI. Claim 12 is drawn to a method for detecting a target polynucleotide comprising amplifying said polynucleotide or fragment, classified in class 435, subclass 6.
 - VII. Claims 13 and 18 are drawn to a method for treating disease or condition associated with decreased expression and associated composition, classified in class 436, subclass 54.1.
 - VIII. Claim 14 is drawn to a method for screening a compound for effectiveness

- IX. Claim 15 is drawn to a method for screening a compound for effectiveness as an antagonist, classified in class 435, subclass 69.2.
 - X. Claim 16 is drawn to a method for screening a compound for effectiveness in altering expression of a target polynucleotide, classified in class 435, subclass 441.
 - XI. Claim 17 is drawn to a method for assessing toxicity of a test compound, classified in class 435, subclass 32.
 - XII. Claims 19-20 are drawn to a composition comprising an agonist and associated method of treatment, classified in class 435, subclass 193.
 - XIII. Claims 21-22 are drawn to a composition comprising an antagonist and associated method of treatment, classified in class 435, subclass 173.8.
 - XIV. Claim 23 is drawn to a method of screening for a compound that specifically binds to the polypeptide, classified in class 435, subclass 4.
 - XV. Claim 24 is drawn to a method for screening for a compound that modulates the activity of the polypeptide, classified in class 435, subclass 15.
2. The inventions are distinct, each from the other because of the following reasons:
- The methods of Group I, V, VI, and any of VIII-XV are distinct as claimed because they have different methods with different method steps; different functions and the effects have different final outcomes. Group I is drawn to a method for detecting a polypeptide while the other groups are drawn to methods of detecting.

Art Unit: 1645

assessing each have different steps comprising hybridizing, amplifying, exposing, treating, administering or combining, therefore each method comprises different steps. Moreover, each method provides different results. The different methods recited in each group do not utilize the same starting reagents. Each group produces different effects and different functions when compared to the other groups. Therefore, the inventions are unrelated.

Inventions II, III, IV or VII are related as different products. The products are distinct as claimed because they have different structures and different uses. Group II is drawn to a polynucleotide that has a distinct structure representative of its nucleic acid sequence, which is unlike any other group. Moreover, the transgenic organism, antibody and pharmaceutical composition all have different uses. For instance the antibody can be used to elicit an immune response in a patient; moreover the antibody has a different structure as compared to the other products recited in the groups. Each group has a different function, effect and is capable of use without the other. For instance, the pharmaceutical composition does not require the antibody or the transgenic organism to function. Each group has a different structure, produces different effects and has a different function from the other group. Therefore, the products of the inventions are distinct as claimed.

3. Because these inventions are distinct for the reasons given above and have
distinct functions in the art as shown by their different classification, restriction

Art Unit: 1645

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-V, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is

alternate Fridays.

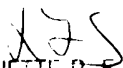
Art Unit: 1645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 703-308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ja-Na Hines: 

August 26, 2002


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600